

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

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| In re patent application of: |) MMB Docket No.: 1776-0035 |
| |) |
| Inventor: Neville et al. |) Xerox Docket No.: D/A 2554 |
| |) |
| Application No.: 10/648,414 |) Examiner: Melvin H. Pollack |
| |) |
| Filed: August 26, 2003 |) Group Art No.: 2145 |
| |) |
| For: Peripheral Device Diagnostic Method And Architecture |) Confirmation No.: 4003 |
| |) |

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REPLY BRIEF

Hon. Commissioner of Patents and Trademarks
Alexandria, VA 20231

Sir:

In reply to the Examiner's Answer mailed July 22, 2008, Applicant asserts that the Examiner's Answer fails to establish a motivation for the combination of Aauschi and Skaanning and thus, no *prima facie* case of obviousness has been made. As this combination is foundational to all of the section 103 grounds of rejection presented in this appeal, the Board is asked to reverse the Examiner on

all of the rejections. The failure of the Examiner to meet his burden of proof is set forth in more detail below.

REPLY

In the Answer, the Examiner asserted that "Asauchi and Skaanning both teach responders with the same functionality at (as?) the applicant's web server." *Answer*, p. 10, first full paragraph. The parenthetical question indicates the Applicant thinks the statement has a typographical error in it. Regardless of the possible typographical error, the clear intent of the assertion is that Skaanning teaches a "printer responder," which performs the reporting functionality. *Answer*, p. 11, second full paragraph. This interpretation of Skaanning is wrong.

The Examiner's interpretation of Skaanning is based on a perceived ambiguity. *Answer*, p. 10, line 3. Skaanning, however, is hardly ambiguous. The communication with the diagnostic system in Skaanning is specifically taught as being between the diagnostic system and *the user* at a customer PC. *Skaanning*, col. 8, lines 60-66. The customer provides information to the diagnostic system. *Id.*, col. 9, lines 1-2. The information is obtained either by a user performing an action and reporting the result, or by a user answering a question from the diagnostic system. *Id.*, col. 12, line 44 to col. 13, line 14. The responses for actions are either a yes or no, while questions can have any number of answers. *Id.*, col. 13, lines 11-14. Thus, the lines 207 and 208 in FIGURE 1 of Skaanning represent information entered by the user of the customer PC. These lines are not indicative of a peripheral device HTTP message being sent to a web browser

by a web server executing in a peripheral device and being forwarded to a backend server as required by the claims.

This structure of Skaanning is very different than the structure of Asauchi. Asauchi is a system that performs diagnostics in a manner not requiring user intervention for the capture and delivery of the diagnostic information. Thus, Asauchi does not require the overhead cost of a person interacting with the diagnostic system, performing test actions, and answering questions in response to interaction with the diagnostic system. Yet, the Examiner insists that "one of ordinary skill in the art would have added Skaanning to Asauchi in order to lower diagnosis costs for end users." *Answer*, p. 4, paragraph 4. The cost addressed in the reference citation given in support of this motivation is the elimination of a call agent. *Skaanning*, col. 1, lines 10-15. The embodiment entitled "User Support Centered On Artificial Intelligence," which begins at col. 7, line 45 of Asauchi, however, describes a diagnostic system that does not require call agents. Thus, Skaanning does not save any costs over this embodiment of Asauchi. Consequently, no motivation has been proven for the combination.

In fact, Skaanning uses an approach criticized by Asauchi, namely, the acquisition of diagnostic data through a general user. *Asauchi*, col. 1, lines 25-30. Therefore, the cited references teach away from one another and demonstrate that the Examiner has provided no credible evidence that one of ordinary skill in the art would combine the references in the manner described by the Examiner. Because Applicant's specification is the only reference that teaches the constructing and sending of a peripheral device HTTP message to a web

browser from a web server executing in the peripheral device and the forwarding of the peripheral device HTTP message to the backend server, the Examiner has impermissibly applied Applicant's specification to the cited references to arrive at the claimed invention. This ill-founded construction does not present a *prima facie* case of obviousness and, therefore, all section 103 rejections of claim 1-22 should be reversed.

Respectfully submitted,
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